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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/979,567	11/26/1997	KAZUO SHIOTA	2091-0145P-S	5872
2292 7590 03/24/2008 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				
EXAMINER KAMAL, SHAHID				
ART UNIT 3621		PAPER NUMBER		
NOTIFICATION DATE 03/24/2008		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary

Application No.

08/979,567

Applicant(s)

SHIOTA ET AL.

Examiner

SHAHID KAMAL

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-15, 17-21 and 23-33 is/are pending in the application.
- 4a) Of the above claim(s) 6-8, 10-15, 17-21, 23-27, and 29-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, and 28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SI/08)
Paper No(s)/Mail Date: 04/06/2006, 08/30/2006
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Acknowledgements

1. This Office Action is response to the reply filed on January 25, 2008.
2. The claims 1-3, 5-8, 10-15, 17-21, and 23-33 are currently pending.

Election/Restriction

3. Applicant's election with traverse of Group-I in response filed on January 25, 2008 is acknowledged. The traversal is on the ground(s) that examination can be made without serious burden. This is not found persuasive because the extensive amendments change claim scope (see MPEP 8.25).
4. The requirement is still deemed proper and is therefore made FINAL.
5. Claims 6-8, 10-15, 17-21, 23-27, and 29-33 are withdrawn from further consideration by the examine, 37 CFR 1.142(b) as being drawn to a non-elected Species, the requirement having been traversed (see MPEP 8.05).
6. In light of mandatory search requirements for patent applications classified in 705 is combination with the extensive claim amendments, it is the Examiners position that a serious burden exists.

Information Disclosure Statement

7. The Information Disclosure Statement filed on 30 August 2006 and 06 April 2006 has been considered. An initialed copy of the Form 1449 is enclosed herewith.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moghadam et al. (US Patent No.: 5,799,219) ("Moghadam") in view of Cameron et al. (US Patent No.: 5,592,378) ("Cameron") further in view of Cloutier et al. (US patent No.: 5,229,810) ("Cloutier").

10. Referring to claim 1, Moghadam discloses: a) recording **in a portable recording medium**, high resolution picture image data obtained by reading a developed film [see at least figure 4(42-shows a photo imaging workstation "PIW" used or get digital images from developed film), and column 2, lines 12-26 (photo imaging station to create digital images from developing film)] and **further recording, in the same portable recording medium**, printing service information regarding **one or more available** printing services which can be provided for the high resolution picture image data, said printing service information being updateable information **which represents an updated selection of one or more available printing services for said image data** [see at least figure 5(84), column 3, lines 1-3, column 6, lines 3-8 (printing service information was recorded for a customer order and displayed and generating the updated order information)];

11. b) **reading said printing service information from said portable recording medium using order processing software installed on a personal computer of a user** [see at least

figure 9(136), column 1, lines 29-45, column 6, lines 19-28 (update data are also available in home or personal computer));

c) **updating a selection of available printing services to be displayed by the order processing software, based on the read printing service information** [see at least column 1, lines 29-45, column 6, lines 19-28 (update data are also available in home or personal computer and display it)];

e) generating print ordering information **response to a user selection of at least one of said picture image data and at least one of the one or more printing services displayed on said order screen** [see at least figure 5, and column 6, lines 3-8 (it explain that the order is generated by selection of the image along with respective sizes and quantity is accomplished by the customer entering next to the respective image number the selection choice)];

Moghadam does not expressly disclose d) displaying **an order screen on a display of the personal computer of the user, wherein said order screen is created by the order processing software and comprises the updated selection of said one or more available printing services and at least one of the picture** image data recorded in the portable recording medium.

Cameron discloses d) displaying **an order screen on a display of the personal computer of the user, wherein said order screen is created by the order processing software and comprises the updated selection of said one or more available printing services and at least one of the picture** image data recorded in the portable recording medium [see at least figure 5, and column 6, lines 3-8 (it explain that the order is generated by selection of the image along with respective sizes and quantity is accomplished by the customer entering next to the respective image number the selection choice)].

Therefore, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified of Moghadam to include the step(s) taught by Cameron as discussed above in order to provide flexibility in how the owner of a digital work may allow it to be distributed.

Moghadam/Cameron combination does not disclose f) wherein the printing service information includes a plurality of attributes including a name of an apparatus and/or a service provider by which the printing service information has been recorded in the portable recording medium.

However, Cloutier discloses f) wherein the printing service information includes a plurality of attributes including a name of an apparatus and/or a service provider by which the printing service information has been recorded in the portable recording medium [see at least figure 7(name of the machine used)].

Therefore, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified of Moghadam/Cameron combination to include the step(s) taught by Cloutier as discussed above in order to provide customer to know the service provider machine name.

Referring to claim 2, Moghadam further discloses wherein the printing service information includes the sizes in which a print can be generated [see at least figure 5 (display available sizes), column 6, lines 3-8 (user select individual images along with their respective sizes)] and.

Moghadam does not expressly disclose the service charges therefore.

Cameron discloses the service charges therefore [see at least figure 22 and 23, (service charges for purchase of goods)].

Therefore, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified of Moghadam to include the step(s) taught by Cameron as discussed above in order to provide clients to easily place orders with known the different sizes that are available and charges the different fees for different sizes.

Referring to claim 3, Moghadam does not expressly disclose wherein the printing service information includes information regarding the available time period of the printing services.

Cameron discloses wherein the printing service information includes information regarding the available time period of the printing services [see at least column 17, column 60-67, column 18, lines 1-8 (customer has told if the item is not in stock)].

Therefore, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified of Moghadam to include the step(s) taught by Cameron as discussed above in order to provide the clients to easily place orders with known the different sizes that are available and charges the different fees for different sizes and monitoring the printing time.

Referring to claim 5, Moghadam does not expressly disclose a picture print ordering method as defined in any one of Claims 1 to 3 wherein the printing service information includes information showing the kinds of finishing processing which can be carried out on the picture image when the picture image is printed [see at least column 3, lines 1-3 (user may select and order which prints they would like to receive)].

Referring to claim 28, Moghadam further discloses wherein the printing service information is updated printing service information for updating the order screen and/or deleting a service

which cannot be provided to the user from the order screen [see at least figure 9(150, 136) (user computer can not get the updated information from agent station)], .

7. Examiner's Note: The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the patent examiner should be directed to Shahid Kamal whose telephone number is (571) 270-3272. The Patent examiner can normally be reached on Monday-Thursday (9:00am -7:00pm), Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew J. Fischer can be reached on (571) 272-6779. The fax phone number for this origination where this application or proceeding is assigned is (571) 273-8300.

Art Unit: 3621

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published application may be obtained from either Private PAIR or Public PAIR.

Statuses information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-directed.uspto.gov>.

Should you have any questions on accessing to the Private PAIR system, contact the Electronic Business Center (EBC) at 1(866) 217-9197 (toll free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 1(800) 786-9199 (IN USA OR CANADA) or 1(571) 272-1000.

Shahid Kamal
March 13, 2008

/ANDREW J. FISCHER/
Supervisory Patent Examiner, Art Unit 3621